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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,406	01/15/2004	Eric A. Merz	D/A1377 XERZ 2 00474	6098
27885	7590	08/21/2007		
FAY SHARPE LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			EXAMINER DO, AN H	
			ART UNIT 2853	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/758,406

Applicant(s)

MERZ ET AL.

Examiner

An H. Do

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The Request for Reconsideration on 23 May 2007 has been acknowledged.

#### ***Claim Objections***

1. Claim 35 is objected to because of the following informalities: "a marking material container" in line 3 should be changed to --the marking material container--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7-10, 20-22, 25-28, 35-37, 40-43, 50-52 and 55-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen et al (US 5,406,315).

Allen et al disclose the following claimed features:

Regarding claims 20, 35 and 50, a printer/copier (Column 1, lines 6-11) comprising: a marking material container (20) for holding a marking material (14) and having a phosphorescent material with predetermined phosphor properties; a light source (30) for producing light directed towards the phosphorescent material; a photo detector (38) for detecting light emitted from the phosphorescent material; and a controller (40) for determining characteristics of the light detected by the photo detector (38) and generating information (Figures 3A-3C).

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Regarding claims 21, 36 and 51, wherein the information identifies the marking material container (Figure 3C, element 126).

Regarding claims 22, 37 and 52, wherein the information identifies the marking material (14).

Regarding claims 25-28, 40-43 and 55-58, wherein the marking material is dry ink, liquid ink, solid ink or toner (column 5, lines 5-24).

Regarding method claims 1-4 and 7-10, Allen et al also disclose the method for obtaining information from a marking container for the fact that the above structure is taught.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 6, 23, 24, 38, 39, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al (US 5,406,315) in view of Hillmann et al (US 5,365,312).

Allen et al disclose the claimed invention except for reciting the information identifies the manufacturer and date information.

Hillmann et al teach in Figures 1 and 2 the information identifies the manufacturer and date information (column 4, lines 39-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the manufacturer and date information, as taught by Hillmann et al into Allen et al, for the purpose of identifying the manufacture date of the cartridges or containers.

6. Claims 11-19, 29-34, 44-49 and 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al (US 5,406,315) in view of Jones, II et al (US 2005/0178841).

Allen et al disclose the claimed invention except for reciting the following features:

Regarding claims 29, 30, 44, 45, 59 and 60, wherein the phosphor properties includes emission properties including an emissions decay rate.

Regarding claims 31, 32, 46, 47, 61 and 62, wherein the emission properties include an emission wavelength.

Regarding claims 33, 34, 48, 49, 63 and 64, wherein the phosphor properties includes absorption wavelength.

Jones, II et al teach the following features:

Regarding claims 29, 30, 44, 45, 59 and 60, wherein the phosphor properties includes emission properties including an emissions decay rate (Page 3, paragraph [0037] to page 4, paragraph [0039]).

Regarding claims 31, 32, 46, 47, 61 and 62, wherein the emission properties include an emission wavelength (Page 8, paragraph [0083]).

Regarding claims 33, 34, 48, 49, 63 and 64, wherein the phosphor properties includes absorption wavelength (Page 3, paragraph [0032]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include container having a phosphorescent material with predetermined phosphor properties such as emission decay rate and absorption wavelength, as taught by Jones, II et al into Allen et al, for the purpose of obtaining security information for a given product (Page 2, paragraph [0010]).

Regarding method claims 1-19, Allen et al as modified by Jones, II et al also teach the method for obtaining information from a marking container for the fact that the above structure is taught.

### ***Response to Arguments***

7. Applicant's arguments filed 23 May 2007 have been fully considered but they are not persuasive. Applicant argued that Allen does not teach or suggest using a phosphorescent material having phosphor properties for emitting light with characteristics and sensing for emitted light coming from the phosphorescent material corresponding to obtain information from the marking material container. However, this argument is not found persuasive because Allen does mention using a phosphorescent material which changes color when it changes phase. Further, Allen senses for light that is reflected from the window and/or phase change material.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to An H. Do whose telephone number is 571-272-2143. The examiner can normally be reached on Monday-Friday (Flexible).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on 571-272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD  
August 18, 2007

/An H. Do/  
Primary Examiner  
Art Unit 2853